

Remarks

New claims 20 to 23 have been added to more thoroughly define the subject matter applicants regard as their invention. Support for the limitations in claims 20 and 21 can be found in the original specification, at page 8, line 1 and page 9, lines 1 and 2, as well as Fig. 3a. Support for the limitations in new claims 22 and 23 regarding the microparticles consisting essentially of the polymers from which they are formed can be found in the description of the figures in the specification.

The rejection of the claims under 35 U.S.C. §103 is respectfully traversed. MPEP §2143 makes clear that, in order to make out a *prima facie* case of obviousness, the prior art must show or suggest **all** features of the invention claimed. In this case, the cited prior art wholly fails to disclose or suggest a manufacturing process in which microparticles which have been deposited onto a substrate carrying a dissolvable material are **released into a solution** by placing the substrate into a solvent for the dissolvable material, as specified in both claims 8 and 14.

In the process illustrated in Fig. 3 of the Brewer patent, which the examiner apparently relies on for suggesting this feature, semiconductor structures 110 remain integrally bound to one another via handle wafer 150 and filler layer 155 long after the “substrate carrying the dissolvable material,” *i.e.*, substrate 130 and etch stop layer 120, are removed therefrom. *See*, Fig. 3g. Consequently, Brewer’s semiconductor structures 110 are not “released into solution” by “placing said substrate in a solvent to dissolve said dissolvable material,” as called for in these claims. Consequently, even when Brewer is considered in combination with Suleski and the other cited references, a *prima facie* case of obviousness is not made out because there is no reasonable suggestion of the **released into solution** limitation of this claim, *i.e.*, that the polymer microparticles are released into solution by placing the substrate on which they have been deposited in a solvent for the dissolvable material also carried by the substrate.

Furthermore, no reasonable person of ordinary skill in the art of polymer microparticles would regard the semiconductor structures 110 of the Brewer patent to be “polymer microparticles” merely because they include a small amount of patterning polymer on their top surfaces. *See*, col. 9, lines 20-22. In this connection, note page 2, lines 16-24 of the specification which explains that “polymer microparticles” are well-known articles of commerce

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in biomedical applications composed predominantly of polymers. The semiconductor structures 110 of the Brewer patent are composed predominantly of semiconductor materials, and hence would not be regarded as “polymer microparticles” as that term is understood in the art. Accordingly, the cited Brewer, Suleski and the other cited references fail to make out a *prima facie* case of obviousness for a second and independent reason, *i.e.*, they fail to suggest making “polymer microparticles,” as expressly claimed. MPEP §2143 (The prior art must show or suggest **all** features of the invention claimed to make out a *prima facie* case of obviousness.)

Newly presented claims 20 and 22 specify that the polymer microparticles are deposited directly on the dissolvable material on the substrate, which is clearly not suggested in the cited references. Meanwhile, claims 21 and 23 indicate that the polymer microparticles “consist essentially” of the indicated polymers, thereby excluding Brewer’s semiconductor structures 110 which are formed predominantly from semiconductor materials. Accordingly, these claims are clearly patentable, applicants believe.

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Respectfully submitted,

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